



An Agency of the United States  
Department of Commerce

## Fax Cover Sheet

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**To: Ms. Cynthia K. Nicholson**

**Fax: (202) 942-8484**

**From: Jon Ouellette**

**Fax: (703) 308-3691**

**Documents Attached: 35  
(Including Cover)**

**Re: Application 09/460,806**

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6/11/2003

Please find the attached reference citation correction (Form 892, Office Action, and References) per you request.

If you require additional information – please call me (703) 605-0662.

Thank You,

A handwritten signature in black ink, appearing to read "Jonathan Ouellette", is written over the printed name. The signature is stylized with a large, sweeping initial "J" and "O".

Jonathan Ouellette

## DETAILED ACTION

### *Drawings*

1. The changes to the drawings have been reviewed and are approved.

### *Double Patenting*

2. The nonstatutory double patenting rejection is withdrawn based on the terminal disclaimer submitted by the registered attorney on 12/23/02.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, Pinnisi & Michaels, PC (Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) in view of InventNet (Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).
5. As per independent Claims 1, 8, 11, 15, 21, and 24, BPM discloses a computer implemented method (method of operating an information service, method of operating an information system, a computer program product encoded in a computer readable medium) for transacting intellectual property annuity, maintenance or renewal fee

payments, the method comprising: providing, responsive to docket data, information representative of one or more intellectual property matters and one or more fee payments associated therewith, wherein the fees include one or more of: annuity, maintenance or renewal fee payments; and in response to selection by a user of one or more of the intellectual property matters and associated one or more fee payments, initiating performance of the selected one or more fee payments, and substantially coincident with initiating thereof, initiating a payment transaction corresponding to the selected one or more fee payments between the user and an intellectual property annuity, maintenance or renewal fee payment service (Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998)

6. BPM fails to distinctly disclose one or more target jurisdictions.
7. InventNet teach the registration and selection of one or more target jurisdictions (Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).
8. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included one or more target jurisdictions as disclosed by InventNet in the system disclosed by BPM, for the advantage of providing a method of transacting an intellectual property service with the ability to widen customer services capabilities by offering intellectual property services in a multitude of jurisdictions (US and foreign).
9. As per Claim 2, BPM and Invent Net disclose wherein the intellectual property services include one or more of paying an annuity of maintenance fee, making an intellectual property filing on behalf of the user, and preparing and/or filing target jurisdiction-

specific and associate-specific form documents for directing and or effecting the filing and/or payment thereof (BPM: Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).

10. As per Claim 3, BPM and Invent Net disclose wherein the fee transacting includes one or more of authorizing a debit of deposit account, supplying an invoice, and processing the fee via a payment system (BPM: Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).
11. As per Claim 4, BPM and Invent Net disclose presenting a user with one or more target jurisdictions and one or more respective associates for each of at least a portion of said target jurisdictions, wherein the fees associated with a particular one or ones of the intellectual property services are further particularized by target jurisdiction and/or said one or more respective associates (BPM: Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).
12. As per Claim 5, BPM and Invent Net disclose automatically initiating the providing of information representative of one or more intellectual property services in response to a docket event for a particular intellectual property matter corresponding thereto (BPM: Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).

13. As per Claim 6, BPM and Invent Net disclose retrieving information characterizing an intellectual property application corresponding to one or more intellectual property services from a data store; and calculating the associated one or more fees based on at least a portion of the intellectual property application information (BPM: Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).
14. As per Claim 7, BPM and Invent Net disclose supplying information encoding the selected one or more intellectual property services and the associated one or more fees for use in an accounting system (BPM: Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).
15. As per Claim 9, BPM and Invent Net disclose wherein the providing of information representative of one or more intellectual property matters and associated one or more fee payments, and the initiating performance of the selected fee payments are performed by the intellectual property annuity, maintenance or renewal fee payment service (BPM: Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).
16. As per Claim 10, BPM and Invent Net disclose wherein at least the providing of information representative of one or more intellectual property matters and associated one or more fee payments is performed by an intermediary separate from the intellectual property annuity, maintenance or renewal fee payment (BPM: Internet Archive WayBack

Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).

17. As per Claim 12, BPM and Invent Net disclose wherein the distributing is responsive to selection by the user of one or more of the target jurisdictions and, for each selected target jurisdiction, a respective one or ones of the associates (BPM: Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).
18. As per Claim 13, BPM and Invent Net disclose wherein the distributing includes supplying, on a periodic basis, to the user, of the computer readable encoding of fees.
19. As per Claim 14, BPM and Invent Net disclose wherein the distributing is encoded by or transmitted in at least one computer readable medium selected from the set of a disk, CD-ROM, tape or other magnetic, optical, or electronic storage medium in a network, wire line, wireless or other communications medium (BPM: Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).
20. As per Claim 16, BPM and Invent Net disclose wherein for a particular selected target jurisdiction and associate combination, the one or more fees include: one ore more official fees for an intellectual property filing in the particular selected target jurisdiction; and one or more service fees of the selected associate for performing the selected at least one intellectual property service (BPM: Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).

21. As per Claim 17, BPM and Invent Net disclose wherein the originating node includes a computer of the managing attorney or intellectual property owner; and wherein the target nodes include computers of respective associates configured to electronically receive at least partial instructions concerning an intellectual property filing from the managing attorney or intellectual property owner via the intellectual property service portal (BPM: Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).
22. As per Claim 18, BPM and Invent Net disclose wherein the originating node includes a web browser; wherein the intellectual property service portal includes a web server; wherein the selection of at least one intellectual property service, the supplying of the information representative of one or more fees, and the transacting of the one or more fees are achieved at least in part, using internet protocol traffic between the web browser and the web server (BPM: Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).
23. As per Claim 19, BPM and Invent Net disclose wherein the intellectual property filing portal is further responsive to registration by the associates of information representative of one or more fees corresponding to the associate; wherein the supplied information representative of one or more fees include those registered by the selected associates (BPM: Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).

24. As per Claim 20, BPM and Invent Net disclose wherein the network includes one or more of a packet switched network segment, a circuit switched network segment, a public network segment, a private network segment, a public switched telecommunications network segment, and a virtual private network (BPM: Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).
25. As per Claim 22, Ferguson and Hunter disclose wherein the selection code and the fee transaction code are all executable on a same processor (BPM: Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).
26. As per Claim 23, Ferguson and Hunter disclose a computer program product encoded by or transmitted in at least one computer readable medium selected from the set of a disk, tape or other magnetic, optical, or electronic storage medium and a network, wire line, wireless or other communication medium (BPM: Internet Archive WayBack Machine, [www.lightlink.com/bbm](http://www.lightlink.com/bbm), 2/24/1998) (InventNet: Internet Archive WayBack Machine, [www.inventnet.com](http://www.inventnet.com), 12/3/1998-2/9/1999).

### *Conclusion*

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
28. The following patent is cited to further show the state of the art with respect to Foreign Patent application processing systems in general:



**U.S. Pat. No. 5,175,681 to Iwai et al.**

Iwai discloses a computerized system for managing preparation a prosecution of applications for protection of industrial property rights in various countries.

29. The following foreign patent is cited to show the best foreign prior art found by the examiner:

**Japanese Pat. No. JP 10171843 A to Nakamoto**

Nakamoto discloses an information monitoring system for patent application registration management, which searches differential indication files for obtaining differences between records of a monitoring object, and is output as a report data examination application – the system also includes assessment data and jurisdiction data management.

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Friday, 8am - 4:30pm.
31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-3597 for After Final communications.

Art Unit: 3629

32. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

jo

June 11, 2003

**Notice of References Cited**

Application/Control No.

09/460,806

Applicant(s)/Patent Under  
Reexamination  
LEE, EUGENE M.

Examiner

Jonathan Ouellette

Art Unit

3629

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**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,175,681	12-1992	Iwai et al.	705/9
	B	US-6,049,811	04-2000	Petruzzi et al.	715/507
	C	US-2002/0069154 A1	06-2002	Fields, Scott J.	705/37
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N	JP 10171843 A	06-1998	Japan	NAKAMOTO, SHINYA	G06F 17/30
	O	WO 9826343 A2	06-1998	World Intellect	PETRUZZI et al.	G06F 0/
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Internet Archive WayBack Machine, <a href="http://www.inventnet.com">www.inventnet.com</a> , 12/3/1998-2/9/1999.
	V	Internet Archive WayBack Machine, <a href="http://www.lightlink.com/bbm">www.lightlink.com/bbm</a> , 2/24/1998.
	W	PCT-Easy, User Reference Manual, PCT-EASY V 2.80, World Intellectual Property Organization ( <a href="http://www.wipo.int/">www.wipo.int/</a> ), January 1999.
	X	Forstner, James A., "Managing international patent litigation," Managing Intellectual Property Litigation Yearbook, PP: 3-6, 1995.

A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

<b>Notice of References Cited</b>	Application/Control No. 09/460,806	Applicant(s)/Patent Under Reexamination LEE, EUGENE M.	
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**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-			
	B	US-			
	C	US-			
	D	US-			
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	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

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	N					
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	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	www.inventnet.com
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.